

**REMARKS**

Reconsideration and continued examination of the above-identified application are respectfully requested.

The amendment to the claims further defines what applicants regard as their invention. Full support for the amendment exists in the application as originally filed, for instance, at page 4, lines 15-16 of the application. Accordingly, no questions of new matter should arise and entry of the amendment is respectfully requested.

The present amendment adds two new claims. Claim 31 recites some of the various embodiments of the surface covering, such as a floor, a wall, a ceiling, a deck, or a kitchen countertop. Claim 32 is drawn to the specific embodiment in which the surface covering is a floor. These new claims emphasize differences between the claimed invention and the cited references, particularly the Peralt Anstalt reference. As noted more fully below, Peralt Anstalt refers to an overlapping configuration of panels used in roofing applications. By contrast, in one embodiment, the claimed invention is for indoor applications, particularly flooring applications, in which an overlapping shingle configuration is not used.

At page 2 of the Office Action, the Examiner discusses the restriction requirement previously imposed and states that an affirmation of the provisional election made on January 14, 2002 must be made in replying to this Office Action. The applicants hereby affirm the provisional election identified above (Group I, claims 1-6, 19-20, 22-23, and 27). In the opinion of the applicants, once claims of Group I are allowable, the subject matter of Group II would also be allowable. Accordingly, there would be no serious burden on the Examiner to search all of the claims at this time. Accordingly, the restriction requirement should be withdrawn.

At page 3 of the Office Action, the Examiner rejects two terms in the claims under the provisions of 35 U.S.C. §112, second paragraph. First, the Examiner rejects the term "lamine" in claim 23 as a relative term, which renders the claim indefinite. The Examiner believes that the identified term is not defined by the claim, and that the specification does not provide a standard for ascertaining the requisite degree, and that one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In the same paragraph, the Examiner also indicates that the term "capable" in claims 1 and 19 is a relative term, which renders those claims indefinite. The Examiner believes that the term "capable" is not defined by claims 1 and 19, and that the specification does not provide a standard for ascertaining the requisite degree, and that one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For the following reasons, these rejections are respectfully traversed.

As for the first term, the word "lamine" is a common term that is frequently used in the flooring industry. Thus, the meaning of this term would be completely clear to persons of ordinary skill in the art of surface coverings and related applications. The concept that a polymeric plank may have a core and another layer laminated to the surface of the core is straightforward. Moreover, the details of the construction of such a plank are set forth at page 4, lines 17-29, as well as in the patent applications incorporated by reference in the cited text. These citations provide even further examples of laminates, particularly to a person of ordinary skill in the art of surface coverings and flooring applications.

Likewise, the term "capable" is a term that is in common usage, appears in granted U.S. patents, and would be immediately known to a person skilled in the art. Further, examples of such

solvents are provided in the application, and thus one skilled in the art would clearly understand the scope of this claim. If the Examiner would prefer an alternate term, a suggestion is respectfully solicited.

Accordingly, for the reasons set forth above, this rejection should be withdrawn.

At pages 3-4 of the Office Action, the Examiner rejects claims 1-6 under 35 U.S.C. §102(b) as being unpatentable over Peralt Anstalt (GB 1,178,565). More specifically, the Examiner states that Peralt Anstalt shows a surface covering comprising two or more polymeric planks having edges, wherein the planks are connected to each other by a bonding agent, wherein the bonding agent is present on at least one of the edges, of at least one of the planks, and wherein the bonding agent is composed of at least one solvent capable of at least bonding the edges of the planks, as shown at column 1, lines 17-22. The Examiner also notes that Peralt Anstalt shows that the bonding agent consists of tetrahydrofuran (THF), as shown in column 1, lines 30-31. The Examiner also states that Peralt Anstalt shows the surface covering, wherein the bonding agent is various identified organic solvents as stated at column 1, lines 30-31. Finally, the Examiner states that Peralt Anstalt shows that the bonding agent is present on at least each edge of each thermoplastic plank connected together to another thermoplastic plank, and that Peralt Anstalt shows that the bonding agent is present on two opposite edges of each plank, as shown at column 1, lines 17-22. For the following reasons, this rejection is respectfully traversed.

Peralt Anstalt shows a different product that is joined together in a completely different manner. Peralt Anstalt is directed to the sorts of exterior panels that are used in roofing applications, and the term "overlapping" appears in the text (page 1, lines 16-19) and in the claims. Such a configuration would be typified by the overlapping of shingles on a roof, or clapboard on a

house, and this configuration is confirmed by reference to the Figures. Such an overlapping configuration would be essential to ensure a watertight seal in outdoor applications, such as the roofs mentioned in the specification.

By contrast, in the claimed invention, the planks are designed preferably for floors, walls, countertops, etc. In such applications, the joining would be ~~edge-to-edge~~, with no overlap of any kind, to produce a flat surface. The present wording of the claims does not show the overlapping configuration found in Peralt Anstalt. In fact, the claims specifically mention the bonding agent being applied to the "edges" of the planks, as in claim 1.

Additionally, the Examiner quotes a large number of potential welding agents in the Office Action, and, as support, cites column 1, lines 30-31. With the exception of THF, the applicants are not able to locate the extensive listing of the welding agents that the Examiner believes are present in the cited portion of Peralt Anstalt. The Examiner is respectfully requested to identify where these welding agents are located in Peralt Anstalt.

As for the Examiner's remarks about the application of the bonding agent to "two opposite edges" of each plank, this term does not appear in the passage cited by the Examiner (column 1, lines 17-22). To the contrary, the identified passage specifically refers to "overlapping edges." Therefore, as noted before, the final configuration of the planks in Peralt Anstalt is clearly overlapping, not edge-to-edge, as would be found in the present invention. Therefore, it is the top and bottom surfaces, not the edges, which actually receive the bonding agent in Peralt Anstalt. From this, it is clear that Peralt Anstalt does not show the claimed invention. Accordingly, the rejection should be withdrawn.

At pages 4-5 of the Office Action, the Examiner rejects claims 19-20 under 35 U.S.C. §103(a) as being unpatentable over Peralt Anstalt in view of Del Rincon et al. (U.S. Patent No. 5,694,730). More specifically, the Examiner states that Peralt Anstalt shows a surface covering as previously described. However, Peralt Anstalt does not show splines located between at least a portion of the polymeric planks, wherein at least a portion of the planks and splines are connected to each other by a bonding agent composed of at least one solvent capable of bonding at least the spline and plank together, wherein the bonding agent is applied to at least one of the edges of at least one of the individual planks, splines, or both. The Examiner also states that Del Rincon et al. teaches splines located between at least a portion of the polymeric planks for the purpose of joining the planks together, as shown at column 1, line 5.

Therefore, the Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have provided Peralt Anstalt with a spline, located between at least a portion of the polymeric planks, in order to join them together as taught by Del Rincon et al. For the following reasons, this rejection is respectfully traversed.

The applicants believe that the rejection is incorrect, for a number of reasons. First, Del Rincon et al. does not relate to the same sort of material as the claimed invention. The claimed invention concerns methods of joining polymeric planks. By contrast, Del Rincon et al. describes wooden planks, as noted in the abstract. Wood is not plastic, and no combination involving Del Rincon et al. could generate the claimed invention.

Second, it is difficult, if not impossible, to see how organic solvents, such as THF, that would clearly bond polymeric materials together, could be used to achieve a similar result with wooden planks. Wood is simply not soluble in organic solvents in the same manner as a polymeric

compound. Therefore, it does not seem that wooden planks could be "welded" together, or to a polymeric plank, using the solvent shown in Peralt Anstalt.

Third, it does not seem physically possible to combine the teachings of the two references. Peralt Anstalt concerns overlapping plastic panels, i.e., panels that are joined together in the manner of shingles. By contrast, Del Rincon et al. concerns wooden boards that are joined edge-to-edge, using a spline. The applicants cannot see how one could physically place a spline between two panels that are not joined edge-to-edge, and Peralt Anstalt clearly relates to a configuration in which the panels are joined in an overlapping manner. Therefore, the applicants believe that the geometrical and spatial requirements of the two references are not physically combinable, and therefore it would not be possible to generate the claimed invention from the teachings of these two references. Accordingly, for all the reasons set forth above, this rejection should be withdrawn.

At pages 5-6 of the Office Action, the Examiner rejects claims 22, 23, and 27 under 35 U.S.C. §103(a) as being unpatentable over Peralt Anstalt in view of Boultinghouse (U.S. Patent No. 4,666,549). More specifically, the Examiner notes that Peralt Anstalt shows a surface covering as previously described, and that Peralt Anstalt shows that the polymeric plank has a polymeric core with a laminate affixed on the surface of the core. The Examiner admits that Peralt Anstalt does not show that the polymeric plank is in the shape of a tile. Additionally, Peralt Anstalt does not show that the bonding agent is composed of at least two different solvents capable of at least bonding the edges of the polymeric portion of the plank. However, in the Examiner's view, Boultinghouse teaches that the bonding agent shows at least two different solvents capable of at least bonding the edges of the polymeric portion of the plank, for the purposes of providing a permanently welded resinous block copolymer, as shown at column 1, line 34 of that reference.

Therefore, the Examiner concludes that it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have provided Peralt Anstalt with a bonding agent comprising at least two different solvents capable of at least bonding the edges of the polymeric portion of the plank, for the purposes of providing a permanently welded resinous block copolymer, as taught by Boultinghouse.

Additionally, the Examiner states that it would have been an obvious matter of design choice to make the plank in the shape of a tile, since such a modification would have involved a mere change in the shape of the component. The Examiner states that a change in shape is generally recognized as being within the level of ordinary skill in the art. For the following reasons, this rejection is respectfully traversed.

The applicants do not believe that the combination of Peralt Anstalt with Boultinghouse shows or teaches the claimed invention in the manner alluded to by the Examiner, for a number of reasons. First, the text cited by the Examiner from Peralt Anstalt (column 1, line 12) does not refer to a polymeric core with a laminate affixed to the surface of the core. The cited text merely refers to sheets of "plastics material." Likewise, the Examiner has not identified any portions of Boultinghouse that refer to a polymeric core with a laminate affixed to the surface of the core. Therefore, no combination of Peralt Anstalt and Boultinghouse could generate the subject matter of claim 23, which refers to a polymeric plank having a polymeric core with a laminate affixed to the surface of the core.

Second, the text cited by the Examiner from Boultinghouse (column 1, line 34) does not show the presence of "at least two different solvents." The applicants have not been able to locate the cited language at the identified portion of the patent. There is text in Boultinghouse that refers

to "at least one hydroxyl-ether and/or keto-ether" (column 1, lines 45-50) or "at least one keto-ether and/or hydroxyl-ether solvent" (column 3, lines 16-18). While the use of the phrase "at least one" might infer that more than one solvent can be used, the reference does not show the specific support for a mixture of two solvents that the Examiner alleges. In fact, there is no suggestion in Boultinghouse that mixtures of solvents are desirable or yield improved properties at all. Therefore, the applicants do not believe that the combination suggested by the Examiner actually teaches or suggests the use of "at least two different solvents," as required by claim 28.

Additionally, Boultinghouse pertains to the specific case when one desires to bind resinous block copolymers containing anti-block agents, such as a microcrystalline wax, as set forth at column 1, lines 17-19. The Examiner has not indicated any specific text that shows whether Peralt Anstalt is made of resinous block copolymers or contains such anti-block agents, as described in Boultinghouse. If Peralt Anstalt is not made of resinous block copolymers, or does not contain anti-block agents, then there would be no motivation to combine the teachings of the two references, when one is specifically concerned with the problems of anti-block agents, such as a microcrystalline wax.

Third, as noted previously, no combination involving Peralt Anstalt could produce the claimed invention, for geometrical and physical reasons. Peralt Anstalt involves an overlapping configuration of panels, while the claimed invention refers to edge-to-edge welding.

Also, claim 22 is a dependent claim. If the independent claim upon which it depends (claim 1) is rendered patentable, then this claim should be patentable as well. The same holds true for the other identified claims (23 and 27) that make up this rejection. The differences between the



claimed invention and Peralt Anstalt have been discussed at length above in conjunction with the rejection of claim 1 and apply equally here.

Accordingly, for all the reasons set forth above, this rejection should be withdrawn.

**CONCLUSION**

In view of the foregoing remarks, the applicants respectfully request the reconsideration of this application and the timely allowance of all the pending claims.

If there are any other fees due in connection with the filing of this response, please charge the fees to Deposit Account No. 50-0925. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and should also be charged to said Deposit Account.

Respectfully submitted,



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